

REMARKS

**Status of the Claims**

Claim 1 has been amended. Claims 2-13 are original claims.

**Claim Rejection under 35 U.S.C. 112**

Claim 1 was rejected under 35 USC 112 first paragraph for undue breadth for the diol component. The Examiner pointed out that original claim 4 more clearly defined the diol in claim 4 as a reaction product. Claims 4 and 7 have been incorporated into claim 1 to more clearly define the diol component and should obviate the 112 rejection. In view of the amendment to claim 1, applicants request withdrawal of the 112 rejection.

**Claim Rejection under 35 U.S.C. 103(a)**

Claims 1-13 were rejected under 35 USC 103(a) as being unpatentable over Yabuta et al. U.S. 5,719,234 (see abstract, cols. 1-4 and claims 1 & 7) in view of Takahashi et al. U.S. 6,713,551, Saika et al. U.S. 6,189,175, or Johnson et al. U.S. 6,350,526 or additionally, in regard to claim 13, Hazan et al. U.S. 5,224,696.

All of these references cited by the Examiner have the same thing in common, i.e., they utilize an ortho ester as a water scavenger or a dehydrating agent in coating compositions. Applicants do not use an ortho ester as a water scavenger or dehydrating agent in fact an ortho ester does not exist in Applicants' composition. In contrast to each of the above cited references, Applicants utilize an orthoester compound that is formed by reacting an ortho ester with a diol which is not taught by any of these references and the diol is clearly defined in the amended claims as the reaction product of hydroxy carboxylic acids with an epoxy containing compound.

To be more precise, Applicants' component A) which comprises 20-80 wt% of the components of the coating composition is the reaction product of an orthoester compound and at least one diol that has been described in the amended claims as the reaction product of a hydroxy carboxylic acid with at least one acid group and at least one hydroxyl group and an epoxy group containing compound or the reaction product of hydroxy carboxylic acids with at least one acid group and at least one hydroxyl group and linear or branched diols. This clearly is not taught by any of the references.

In contrast, Yabuta '234 shows a list of carboxy containing compounds, polyols, vinyl monomers with an epoxy group, reactive organosiloxanes and a

crosslinked particulate polymer and mentions that the coating composition may contain a dehydrating agent, such as, trimethyl orthoacetate to prevent degradation caused by moisture in the air or solvents. Nothing is taught or suggested that the ortho ester compound reacts with any of the other components of the composition. In fact, if there was such a reaction, the ortho ester would be consumed and would cease to be a water scavenger or dehydrating agent. All of the references have the same thing in common, the ortho ester must be present in the coating composition in its un-reacted form to be a water scavenger or a dehydrating agent.

The basis for the Examiner's rejection appears to be that somehow these components of the composition would react with the ortho ester in the Yabuta '234 coating composition to give Applicants' component A. However, there are no such teachings within Yabuta '234 that would lead one to prepare Applicants' component A of his composition. If there are, Applicants would appreciate it if the Examiner would point those teachings out to Applicants.

Trimethyl orthoacetate as disclosed in Yabuta '234 simply is used as a water scavenger. Since the trimethyl orthoacetate is used as an additive, there would be an insufficient amount of the trimethyl orthoacetate present to react and form 20-80% by weight of the binder constituent, as is required for Applicants composition, as set forth in the amended claims. If one did react the trimethyl orthoacetate as suggested by Examiner but not taught or suggested by Yabuta '234, the trimethyl orthoacetate would cease exist and could not be a water scavenger. This is completely contrary to the teachings of the reference since the sole reason for the presence of the trimethyl orthoacetate in the coating composition of Yabuta '234 is to have a water scavenger. Applicants' invention is contrary to the teachings of Yabuta '234 in that the ortho ester is reacted with a diol component not taught by Yabuta '234 and not present in the composition as a free ortho ester water scavenger.

The other three references cited Takahashi et al. U.S. 6,713,551, Saika et al. U.S. 6,180,175, Johnson et al. U.S. 6,350,526 and Hazan et al. U.S. 5,244,696 all have the same deficiencies as Yabuta '234. Each reference discloses the use of orthoesters as water scavengers or dehydrating agents. None teach or suggest the reaction of the orthoesters with a diol to form a binder component of a coating composition which is clearly set forth in Applicants' amended claims. The points made above in regard to Yabuta '234 apply equally to the above 4 references and


will not be repeated. The Examiners position simply is untenable since none of the references cited in the office action teach or suggest the reaction of ortho esters with a diol component to form the main constituent of the binder of a coating composition as set forth in the amended claims. Further, the references each teach that the ortho ester is unreacted so that it is a water scavenger or a dehydrating agent. To take the position that it is a simple range adjustment to go to the 20-80% by weight range for the ortho ester compound as set forth in the claims is equally untenable since the cited references only teach that the unreacted ortho esters are present only as additives. Additives typically are in a range of under 5% and do not make up the bulk of the binder. Furthermore, the ortho ester of the reference clearly is not the ortho ester compound set forth in the amended claims.

Applicants respectfully request that the rejection based on Yabuta, '234, Takahashi '551, Saika '175 Johnson '526 and Hazan '696 be withdrawn since these references alone or in any combination do not teach or suggest Applicants' invention as has been set forth in the amended claim.

#### **SUMMARY**

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance, and therefore respectfully solicit a Notice of Allowance. In order to expedite disposition of the case, the Examiner is invited to contact Applicants' representative at the telephone number below to resolve any remaining issues. Should there be a fee due that is unaccounted for, please charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,

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